



164c

PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | | |
|---|---|------------------------|---------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | | Application Number | 09/665,728 |
| | | Filing Date | September 20, 2000 |
| | | First Named Inventor | Lawrence W. STANTON |
| | | Art Unit | 1646 |
| | | Examiner Name | E. O'Hara |
| Total Number of Pages in This Submission | 6 | Attorney Docket Number | 219002031600 |

| ENCLOSURES (Check all that apply) | | |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply (3 pages) <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input checked="" type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address (2 pages) <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return postcard |
| <div>Remarks</div> <div>Customer No. 25225</div> | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | |
|--|---|
| Firm or Individual name | MORRISON & FOERSTER LLP James J. Mullen, III, Ph.D. - 44,957 |
| Signature | |
| Date | February 5, 2004 |

| | |
|---|----------------------------|
| I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below. | |
| Dated: 2-5-04 | Signature: (Michael Boyd) |



I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 25-01

Signature: 

(Michael Boyd)

Docket No.: 219002031600
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Lawrence W. STANTON et al.

Application No.: 09/665,728

Confirmation No.: 8743

Filed: September 20, 2000

Art Unit: 1646

For: SECRETED FACTORS

Examiner: E. O'Hara

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed January 6, 2004. Accordingly, this response is timely filed.

ELECTION OF INVENTION

Claims 34-47 are pending in this application. Restriction has been required as between the following allegedly distinct groups of inventions:

Group I (claims 34-39), drawn to a method for identifying genes differentially expressed in disease state.

Group II (claims 40-47), drawn to a method for identifying candidate compounds that modify expression of a gene differentially expressed in a disease state comprising providing a candidate compound to the subject in the disease state and determining if the candidate compound modifies expression.

Applicants hereby elect Group I (claims 34-39), without traverse. Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 219002031600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: February 5, 2004

Respectfully submitted,

By 

James J. Mullen, III, Ph.D.

Registration No.: 44,957

MORRISON & FOERSTER LLP

3811 Valley Centre Drive, Suite 500

San Diego, California 92130

(858) 720-7940